

REMARKS

Claims 1-24 are pending in the application.

Claims 1-24 stand rejected.

Claims 2 and 19 stand objected to.

Claims 1-3, and 10-19 have been amended.

Objections to the Specification

Page 2 of the present Office Action has objected to the title of the invention because the present Office Action asserts that the title is not descriptive. Applicants have amended the title to address the concerns outlined in the present Office Action. Applicants respectfully request that the objection be withdrawn.

Objections of the Claims

Claims 2 and 19 have been objected to due to alleged informalities. Applicants have amended Claims 2, and 19 to address the concerns outlined on page 2 of the present Office Action. Thus, Applicants respectfully request that the objection be withdrawn.

Rejection of Claims under 35 U.S.C. §101

Claims 19-24 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants have amended Claim 19 to recite a “system, comprising: a central processing unit (CPU); a memory, coupled to the CPU, the memory further comprising” the recited data structure. Such a system clearly falls within one of the enumerated statutory categories (i.e., process, machine, manufacture, or composition of matter) of patentable subject matter recited in 35 U.S.C. § 101. Since Claim 19 recites statutory subject matter, dependent

Claims 20-24 are also patentable over 35 U.S.C. § 101 by virtue of their dependency on independent Claim 19. Thus, Applicants respectfully request that the rejection be withdrawn.

Rejection of Claims under 35 U.S.C. §103

Pages 3 and 4 of the present Office Action states that Claims 1-24 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Habichler, et al., U.S. Patent No. 2007/0203710 A1 (“Habichler”), in view of Peterson, U.S. Patent Publication No. 7,099,350 B2 (“Peterson”). Applicants respectfully submit that the rejection is not proper because Habichler is disqualified as a reference under 35 U.S.C. § 103(c)(1) because: (1) Habichler qualifies as 35 U.S.C. § 102(e) prior art; and (2) at the time the claimed invention was made, Habichler and the present invention were owned by the same person or subject to an obligation of assignment to the same person.

According to 35 U.S.C. § 103(c)(1), “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Also, according to the Manual for Patent Examining Procedure (MPEP) § 706(l)(1), 35 U.S.C. § 103(c)(1) only applies to all utility design, and plant patent applications filed on or after November 29, 1999.

In the instant case, Habichler was filed on March 29, 2002, which is after November 29, 1999. Habichler also qualifies as 35 U.S.C. § 102(e) prior art because it is “an application for patent by another filed in the United States before the invention by the applicant for patent.” 35 U.S.C. § 102(e). At the time the invention was made (the present application was filed on December 31, 2003, but claims the benefit of a U.S. Provisional Patent No. 60/457,494, filed

March 24, 2003), both Habichler and the present invention were subject to an obligation of assignment to the same person. Applicants have included, in Appendix A, the assignment documents of both Habichler and the present invention, which show that they are both assigned to Siebel Systems, Inc., of San Mateo, California. The inventors of Habichler assigned Habichler to Siebel Systems, Inc., between June 21, 2002 and July 4, 2002. The inventors of the present invention assigned the present invention to Siebel Systems, Inc. between March 4, 2004 to March 8, 2004. Thus, Habichler and the present invention were subject to an obligation of assignment to the same person at the time the invention was made.

Because of at least these reasons, Habichler is disqualified as a prior art reference under 35 U.S.C. § 103(c)(1). Due to the disqualification of Habichler as a reference, the 35 U.S.C. § 103(a) rejection on pages 3-4 of the present Office Action is moot. Thus, Applicants respectfully request the withdrawal of the rejection of Claims 1-24 under U.S.C. § 103(a) and an indication of allowability of those claims.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5084.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to deposit account 502306.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'S. G. Campbell, III', written in a cursive style.

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APPENDIX A

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NOVEMBER 02, 2004

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DOCKET NUMBER: 384818038US1

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DOC DATE: 03/08/2004

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SERIAL NUMBER: 10751011

PATENT NUMBER:

TITLE: POSITION COMMON OBJECT

FILING DATE: 12/31/2003
ISSUE DATE:

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☐ Yes ☒ No

3. Nature of Conveyance:

☒ Assignment

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☐ Security Agreement

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If this document is being filed together with a new application, the execution date of the new application is:

A. Patent Application No.(s):

10/751,011

B. Patent No.(s):

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence
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ASSIGNMENT

WHEREAS, we, Maria Theresa Barnes-Leon, Nardo B. Catahan Jr., Caroline Muralitharan, Darayush Mistry, and Prasad Gune ("ASSIGNORS"), having post office addresses of 288 Rivercreek Drive, Fremont, California 94536, 103 Sonja Road, S. San Francisco, California 94080, 961 Desmet Lane, San Jose, California 95125, 970 Corte Madera Ct, #109, Sunnyvale California 94085, and 2130 Jackson St., #206, San Francisco, California 94115 respectively, are the joint inventors of an invention entitled "POSITION COMMON OBJECT," as described and claimed in the specification for which an application for United States letters patent was filed on December 31, 2003, and assigned Application No. 10/751,011.

WHEREAS, Siebel Systems, Inc. ("ASSIGNEE"), a corporation of the State of Delaware having a place of business at 2207 Bridgepointe Parkway, San Mateo, California 94404, is desirous of acquiring the entire right, title, and interest in and to the invention and in and to any patents that may be granted therefore in the United States and in any and all foreign countries;

NOW, THEREFORE, in exchange for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, ASSIGNORS hereby sell, assign, and transfer unto ASSIGNEE, its legal representatives, successors, and assigns, the entire right, title and interest in and to the invention as set forth in the above-mentioned application, including any continuations, continuations-in-part, divisions, reissues, re-examinations, or extensions thereof, any other inventions described in the application, and any and all patents of the United States of America and all foreign countries that may be issued for the invention, including the right to file foreign applications directly in the name of ASSIGNEE and to claim priority rights deriving from the United States application to which foreign applications are entitled by virtue of international convention, treaty or otherwise, the invention, application and all patents on the invention to be held and enjoyed by ASSIGNEE and its successors and assigns for their use and benefit and of their successors and assigns as fully and entirely as the same would have been held and enjoyed by ASSIGNORS had this assignment, transfer, and sale not been made.

UPON THE ABOVE-STATED CONSIDERATIONS, ASSIGNORS agree to not execute any writing or do any act whatsoever conflicting with this assignment, and at any time upon request, without further or additional consideration but at the expense of ASSIGNEE,

execute all instruments and documents and do such additional acts as ASSIGNEE may deem necessary or desirable to perfect ASSIGNEE's enjoyment of this grant, and render all necessary assistance required for the making and prosecution of applications for United States and foreign patents on the invention, for litigation regarding the patents, or for the purpose of protecting title to the invention or patents therefor.

ASSIGNORS authorize and request the Commissioner of Patents and Trademarks to issue any Patent of the United States that may be issued for the invention to ASSIGNEE.

March 8, 2004
Date

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March 8, 2004
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